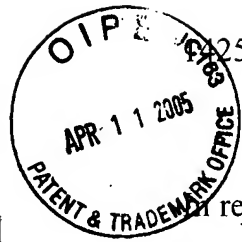


DAE  
DW



25.67029

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

re: Patent Application of )

Applicant: Jack K. Hosking et al. )

Serial No.: 10/689,452 )

Filed: October 20, 2003 )

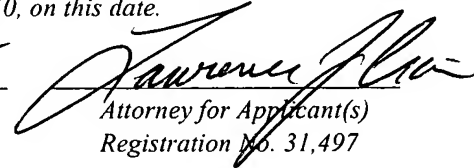
For: RAIL FASTENER DRIVER )  
WITH ENHANCED )  
FASTENER POSITIONING )

Art Unit: 3617 )

Examiner: Mark T. Le )

) I hereby certify that this paper is being deposited with the  
) United States Postal Service as FIRST-CLASS mail in an  
) envelope addressed to: Mail Stop Petition;  
) Commissioner for Patents, P.O. Box 1450, Alexandria,  
) VA 22313-1450, on this date.

) 4/8/05  
) Date

)   
) Attorney for Applicant(s)  
) Registration No. 31,497

**RESUBMITTED PETITION FOR RETROACTIVE  
FOREIGN FILING LICENSE PURSUANT TO 37 C.F.R. § 5.25**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This paper is in response to the Decision mailed March 22, 2005 in the above-identified application. Applicant's Attorney respectfully petitions for reconsideration of the Denial of the earlier filed Petition and for a retroactive foreign filing license in the above-identified application. Applicant's undersigned Attorney inadvertently caused the above-identified application to be filed in Canada on October 20, 2003 without the grant of a foreign filing license. The undersigned, having first hand knowledge of the facts, hereby states that the filing of the Canadian application occurred through error and without

deceptive intent. As required by 37 C.F.R. § 1.17(h), the fee for petition of \$130 is enclosed herewith.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting patent grant, declares that he is properly authorized to execute this application on behalf of the Applicant; and that all statements made of his own knowledge are true, and statements made on information and belief are believed to be true.

Applicant's Attorney states that:

(a) The corresponding foreign application was filed in Canada on October 20, 2003.

(b) The subject matter in question was not under a secrecy order at the time it was filed in Canada, and the subject matter in question is not currently under a secrecy order.

(c) Applicant's Attorney diligently sought a license after discovery of the proscribed foreign filing by submitting herewith a petition for retroactive license shortly after receiving the report from the Canadian foreign associate regarding the Canadian filing.

(d) Applicant's Attorney filed in Canada through error, and without deceptive intent, without the required license under 37 C.F.R. § 5.11 first having been obtained. The facts supporting the conduct that constitutes error without deceptive intent are as follows:

a. Nordco Inc. is the Applicant of the above-identified application.

b. B. Straub, Vice President of Engineering at Nordco Inc., contacted Applicant's Attorney on September 24, 2003, disclosed the subject matter that is the invention of the above-identified application to Applicant's Attorney, and notified Applicant's Attorney that field testing of the subject matter of the above-identified application commenced on or about October 21, 2002.

c. Between September 24, 2003 and October 20, 2003, Applicant's Attorney prepared the application for filing in the United States and Canada.

d. Between September 24, 2003 and October 20, 2003, Applicant's Attorney inadvertently failed to obtain a foreign filing license from the United States Patent and Trademark Office.

e. On October 17, 2003, Applicant's Attorney mistakenly instructed, via e-mail with the order letter attached, the Canadian foreign associate, Mr. Alain Bourassa of the firm Perley-Robertson, Hill & McDougall LLP, located at 90 Sparks Street, Ottawa Ontario, K1P 1E2, Canada, to prepare and file immediately and upon final confirmation, but no later than October 20, 2003, an application in Canada based on the above-identified U.S. Patent Application, also filed on October 20, 2003, in which there was no Serial Number or foreign filing license.

f. Applicant's Attorney mistakenly instructed the Canadian foreign associate to file no later than October 20, 2003 in order to meet the Canadian requirements for filing within a year of the invention being publicly disclosed, and because of this deadline inadvertently neglected to obtain a foreign filing license before submitting these instructions.

g. The legal assistant to the Canadian foreign associate, Maureen Choo, acknowledged receipt of the instructions on October 20, 2003.

h. Applicant's Attorney sent confirmation regarding final approval of the specification to the Canadian foreign associate on October 20, 2003.

i. The Canadian foreign associate filed the application in the Canadian Patent Office on October 20, 2003.

j. Applicant's Attorney filed an application on the same subject matter in the United States Patent and Trademark Office on October 20, 2003.

k. The Canadian foreign associate reported the filing of the Canadian application to Applicant's Attorney on October 20, 2003, which was received by Applicant's Attorney on October 27, 2003.

Applicant's Attorney asserts that error without deceptive intent was committed in filing the application in Canada on the same day the application was filed in the United States, therefore not enabling adequate time for a foreign filing license to be granted by the United States Patent and Trademark Office. This error was inadvertently made by Applicant's Attorney and was made by mistake and without deceptive intent.

Enclosed are the following documents and fees:

(i) Petition fee pursuant to 37 C.F.R. § 1.17(h) for retroactive license in the amount of \$130 (previously submitted);

(ii) A copy of the e-mail, dated October 17, 2003, and the attached order letter to the Canadian foreign associate regarding instructions for filing the application in Canada.

(iii) A copy of two e-mails, both dated October 20, 2003, from the legal assistant to the Canadian foreign associate confirming receipt of instructions.

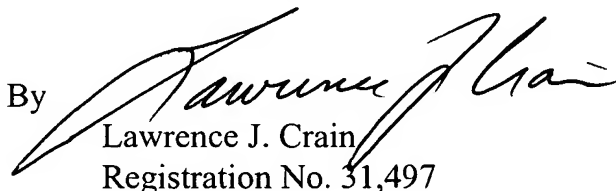
(iii) A copy of the report letter to Applicant's Attorney, dated October 20, 2003, including a copy of the Canadian application.

The Commissioner is authorized by the undersigned to charge any additional fees which may be required to this application, or credit any overpayment, to Deposit Account No. 07-2069. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. A duplicate of this Petition is enclosed.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

  
Lawrence J. Crain  
Registration No. 31,497

April 8, 2005

300 South Wacker Drive  
Suite 2500  
Chicago, Illinois 60606  
Telephone: (312) 360-0080  
Facsimile: (312) 360-9315  
Customer No. 24978

K:\1425\67029\Petition for retroactive license.doc



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re U.S. Patent Application )  
)  
Applicant: Jack K. Hosking et al. )  
)  
Serial No. 10/689,452 )  
)  
Filed: October 20, 2003 )  
)  
For: RAIL FASTENER DRIVER WITH )  
ENHANCED FASTENER )  
POSITIONING )  
)  
Art Unit: 3617 )  
)  
Examiner: Mark T. Le )

*I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop Petition; Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.*

*4/8/05* *Lawrence J. Crain*  
Date Registration No. *31,497*  
F-CLASS.WCM  
Appr. February 20, 1998 Attorney for Applicant(s)

TRANSMITTAL

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

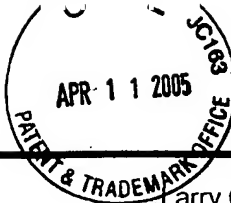
- (X) Enclosed is a Resubmitted Petition for Retroactive Foreign Filing License Pursuant to 37 C.F.R. § 5.25.
- (X) The Commissioner is hereby authorized to charge any additional fees which may be required to this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 07-2069. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. Two duplicate copies of this sheet are enclosed.

April 8, 2005  
Suite 2500  
300 South Wacker Drive  
Chicago, Illinois 60606  
(312) 360-0080  
Customer No. 24978

GREER, BURNS & CRAIN, LTD.

By: *Lawrence J. Crain*  
Lawrence J. Crain, Reg. No. 31,497

Larry Crain



From: Larry Crain [lcrain@gbclaw.net]  
Sent: Friday, October 17, 2003 5:37 PM  
To: Alain Bourassa (E-mail)  
Cc: Morine Choo (E-mail); Vivian DelaRosa (E-mail)  
Subject: URGENT, FILING DUE ON OCT. 20, 2003; Our file 1425.67029

Importance: High

Dear Alain:

Enclosed is the application we discussed. Please wait for final confirmation from us before filing on Monday. Also, please confirm receipt of this e-mail.

Best personal regards,

Larry



ordltr.pdf



CA App.doc



Rev FIGs. 1-6.pdf

Lawrence Crain  
Greer, Burns & Crain, Ltd.  
Suite 2500  
300 S. Wacker Dr.  
Chicago, Illinois 60606

Tel: 312-360-0080  
Fax: 312-360-9315  
www.gbclaw.net

\*\*\*\*\*CONFIDENTIALITY NOTE\*\*\*\*\*

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# GREER, BURNS & CRAIN, LTD.

*Attorneys at Law*

300 SOUTH WACKER DRIVE  
SUITE 2500

CHICAGO, ILLINOIS 60606  
TELEPHONE (312) 360-0080  
FACSIMILE (312) 360-9315

WWW.GBCLAW.NET

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PATRICK G. BURNS  
LAWRENCE J. CRAIN  
STEVEN P. FALLON  
PAUL G. JUETTNER  
JAMES K. FOLKER

CAROLE A. MICKELSON  
JOSH C. SNIDER  
BRITTANY C. MACDONALD  
ARIK B. RANSON  
THOMAS R. FITZSIMONS  
JOSEPH P. FOX  
LAURA R. WANER  
CHARLES C. LAUNCH†

MICHAEL J. BERGNACH  
ROBERT M. PATINO  
THOMAS S. GRZESIK  
BRIAN J. SLOSSON  
PATENT AGENTS

OF COUNSEL:  
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JOHN W. CHESTNUT  
PHILIP M. KOLEHMAINEN  
ROBERT A. LLOYD

SAN DIEGO OFFICE  
110 WEST C STREET  
SAN DIEGO, CALIFORNIA 92101  
TELEPHONE (619) 234-1130

\*ADMITTED IN CALIFORNIA AND ILLINOIS  
†ADMITTED IN TEXAS ONLY

WRITER'S DIRECT DIAL  
(312) 987-4002  
WRITER'S E-MAIL ADDRESS  
LCRAIN@GBCLAW.NET

October 17, 2003

BY E-MAIL &  
FACSIMILE

Mr. Alain Bourassa  
Perley-Robertson, Hill & McDougall LLP  
90 Sparks Street  
Ottawa, Ontario K1P 1E2  
CANADA

URGENT!!!

Re: New Canadian Patent Application  
corresponding to: U.S. Application Serial No. Unassigned  
Filed: October 20, 2003  
entitled: RAIL FASTENER DRIVER WITH  
ENHANCED FASTENER POSITIONING  
Our File No.: 1425.67029

Dear Alain:

Please prepare and **immediately** file an application in Canada based on the above-identified U.S. Patent Application filed October 20, 2003 in which we do not yet have a Serial No. and no later than **October 20, 2003**.

**PLEASE NOTE THAT WE HAVE NOT YET RECEIVED FINAL APPROVAL OF THE SPECIFICATION, BUT EXPECT THAT BY EARLY MONDAY MORNING, OCT. 20. DO NOT FILE THE APPLICATION UNTIL WE SEND YOU FINAL CONFIRMATION.**



The inventors' names and addresses are as follows:

1. Jack K. Hosking  
1821 Ruben Drive  
Waukesha, Wisconsin 53186, U.S.A  
citizen of the United States of America
2. Robert C. Class  
211 Cottrell Drive  
Saukville, Wisconsin 53080, U.S.A  
citizen of the United States of America
3. James W. Fuerst  
2434 N. 86<sup>th</sup> Street  
Wauwatosa, Wisconsin 53226, U.S.A  
citizen of the United States of America

The assignee/applicant, by deed of Assignment is as follows:

NORDCO INC.  
182 West Oklahoma Avenue  
Milwaukee, Wisconsin 53207, U.S.A  
a corporation of the State of Delaware

William D. Straub, Vice President of Engineering, is their designated corporate representative.

Based on: U.S. Patent Application No. Unassigned  
Filed: October 20, 2003  
Title: **RAIL FASTENER DRIVER WITH  
ENHANCED FASTENER POSITIONING**

Based on the above, a priority claim is not deemed necessary.

You are authorized to make any formal corrections to the specification and/or claims, which may be required to place the case in condition for filing.

**Enclosures:** 1 copy of specification

1 set of informal drawings

Formal Documents will follow

Please advise us of what formal documents we will need for the filing in your country.

- Remarks:**
- 1) Please acknowledge receipt immediately of these instructions by facsimile and indicate whether any additional papers are required at this time.
  - 2) Use FIG. 3 for publication, if applicable.
  - 3) Please keep this case in force in the absence of our instructions to the contrary.
  - 4) Please send all correspondence to the above-indicated address and note our reference number in all future correspondence.

Best personal regards,

GREER, BURNS & CRAIN, LTD.

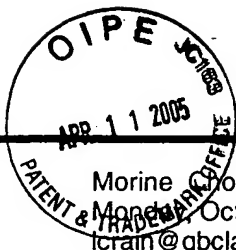
By   
Lawrence J. Crain

LJC:ved

Encls.

K:\1425\67029\CANADA\Canadian ord ltr.doc

Vivian Delarosa



From: Morine Choo [mchoo@perlaw.ca]  
Sent: Monday, October 20, 2003 8:09 AM  
To: icram@gbclaw.net  
Subject: Re: URGENT, FILING DUE ON OCT. 20, 2003; Your file 1425.67029

New Canadian Patent Application

Applicant: Nordco Inc.

Inventors: HOSKING, Jack K.; CLASS, Robert C.; FUERST, James W.

Title: RAIL FASTENER DRIVER WITH ENHANCED FASTENER POSITIONING

Your Reference: 1425.67029

Our File: GBCR-020PCA

We acknowledge receipt of your e-mail instructions of October 17, 2003 to file the above-identified application today, October 20, 2003, pending receipt of confirmation from you to proceed.

We note that there is no need to claim priority, since the corresponding U.S. application is also being filed today. Upon receipt of your instructions to proceed, we will file the application as a large entity, since we note from previous applications filed in the name of Nordco Inc., that they do not qualify for small entity status in Canada. Unless immediately advised by you to the contrary, we will also request examination at the time the application is filed.

We thank you for entrusting this matter to us and await your instructions to proceed with the filing of the application.

Regards.

Morine Choo  
Legal Assistant to Alain D. Bourassa  
Perley-Robertson, Hill & McDougall LLP  
e-mail: mchoo@perlaw.ca  
Telephone No. (613) 238-2022 (Ext. 136)  
Fax: (613) 238-3684

#### Confidentiality Message

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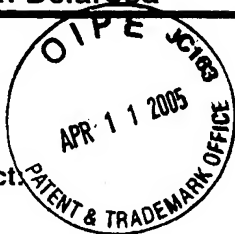
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Vivian Delarosa

---

From: Morine Choo [mchoo@perlaw.ca]  
Sent: Monday, October 20, 2003 10:09 AM  
To: lcrain@gbclaw.net  
Cc: vdelarosa@gbclaw.net  
Subject: Re: URGENT NEW FILING DUE TODAY!!!; Your File 1425.65911 - OurFile: GBCR020



We acknowledge receipt of your instructions and will proceed with the filing of the application today, October 20, 2003.

Regards.

Morine Choo  
Legal Assistant to Alain D. Bourassa  
Perley-Robertson, Hill & McDougall LLP  
e-mail: mchoo@perlaw.ca  
Telephone No. (613) 238-2022 (Ext. 136)  
Fax: (613) 238-3684

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Avis de confidentialité

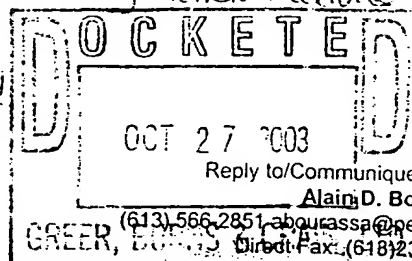
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PERLEY-ROBERTSON, HILL & McDUGALL LLP

Lawyers / Patent & Trade-Mark Agents  
Avocats / Agents de brevets et de marques de commerce

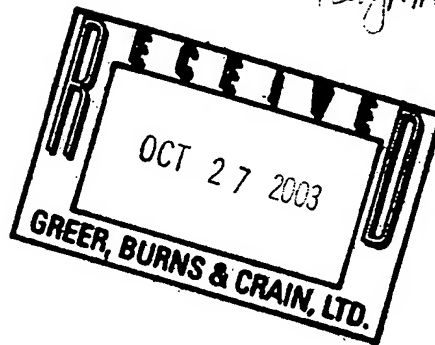
status - report received  
Graham, et al. 10/20/03  
Status, many action received



File Assignment 1-15-04

October 20, 2003

Lawrence J. Crain  
Greer, Burns & Crain  
Suite 300, South Wacker Drive  
Chicago, IL 60606  
U.S.A.



03 OCT 27 AM 9:33

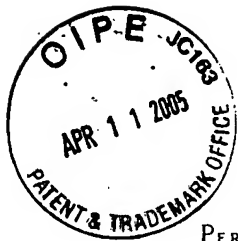
Dear Larry:

Re: New Canadian Patent Application  
Inventors: HOSKING, Jack K.; CLAAS, Robert C.; FUERST, James W.  
Applicant: Nordco Inc.  
RAIL FASTENER DRIVER WITH ENHANCED FASTENER POSITIONING  
Your Reference: 1425.67029  
Our Reference: GBCR-020PCA

Thank you for your letter of October 17, 2003 and accompanying application materials, providing information for filing the above-captioned case in Canada. We also acknowledge your e-mail instructions of October 20, 2003 advising of the correct spelling of the name of inventor Robert C. Claas.

We are pleased to report that the application was hand-filed in the Canadian Patent Office today. Duplicate copies of the Petition, Abstract, Description, Claims, Drawings and our covering letter to the Commissioner of Patents as filed are enclosed. In approximately twelve to fourteen weeks time, we will receive and forward to you the filing certificate which will confirm today's filing date and also provide the serial number allotted this application. The application will be available for public inspection eighteen months from this date.

Annual maintenance fees must be paid to prevent the application from becoming abandoned. The first maintenance fee is payable between the first and second anniversaries of the date of



PERLEY-ROBERTSON, HILL & McDougall LLP

Lawrence J. Grant  
October 20, 2003

filing. The first annuity on this application falls due on **October 20, 2005** and annually thereafter. Failure to make a timely maintenance fee payment against a pending patent application will result in it being deemed abandoned.

Since we did not receive your instructions to the contrary, a request for examination was filed with the application as you will note from our covering letter to the Commissioner of Patents.

Under Canadian practice, it will be necessary to file a recordable title document in favour of the applicant. It is suggested you forward it to us as soon as possible, as otherwise it will be requisitioned by the Patent Office and unless timely filed, could result in abandonment of this case. While the Patent Office will now accept a copy of a transfer instrument for recordal purposes, at a minimum, and on its face, the signature of a subscribing witness should appear. In the event a suitable assignment is not available, we have prepared and enclose an assignment for signature by each of the three inventors. The enclosed assignment should be signed before a witness and the signature of each witness should also appear on the assignment above the "Witness" signing line. The date of signing must also be inserted.

We thank you for entrusting the matter to us.

Our debit note is enclosed.

Yours very truly,

Alain D. Bourassa

ADB:mc

Encls.



COPY

PERLEY-ROBERTSON, HILL & McDUGALL LLP

*Lawyers / Patent & Trade-Mark Agents  
Avocats / Agents de brevets et de marques de commerce*

Reply to/Communiquez avec:  
Alain D. Bourassa  
(613) 566-2851 [abourassa@perlaw.ca](mailto:abourassa@perlaw.ca)  
Direct Fax: (613)238-3684

October 20, 2003

The Commissioner of Patents,  
Ottawa-Hull, Canada.

Dear Sir:

Re: New Canadian Patent Application  
Inventors: HOSKING, Jack K.; CLAAS, Robert C.; FUERST,  
James W.  
Applicant: Nordco Inc.  
RAIL FASTENER DRIVER WITH ENHANCED FASTENER POSITIONING  
Our Reference: GBCR-020PCA

---

In support of the above, we enclose:

1. Petition;
2. Abstract;
3. Description consisting of pages 1 to 11;
4. Claims comprising claims 1 to 21;
5. Drawings, comprising:  
6 sheets and 6 Figures;

Our remittance of today's date includes the below listed sum, calculated as follows:

Filing Fee(Large entity)	\$300.00
Examination fee (Large entity)	\$400.00
Total	\$700.00

### **EXAMINATION REQUEST**

We also request that the application as identified herein be made the subject of examination.



COPY

The Commissioner of Patents  
October 20, 2003

PERLEY-ROBERTSON, HILL & McDOUGALL LLP

Our remittance of today's date also includes the sum of \$400.00 for the prescribed examination fee as set out above.

**ASSIGNMENT**

An assignment in favour of the applicant is not available for filing at this time, but will be submitted as soon as it becomes available.

Yours very truly,

PERLEY-ROBERTSON,  
HILL & McDOUGALL LLP

Per: Alain D. Bourassa

ADB:mc  
Encls.